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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/719,913	11/21/2003	Gary A. Dahl	EPICEN-09580	3340
23535 7590 10/31/2007 MEDLEN & CARROLL, LLP 101 HOWARD STREET SUITE 350 SAN FRANCISCO, CA 94105				
			EXAMINER STAPLES, MARK	
			ART UNIT 1637	PAPER NUMBER
			MAIL DATE 10/31/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/719,913

Applicant(s)

DAHL ET AL.

Examiner

Mark Staples

Art Unit

1637

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07/30/2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 7-40 is/are pending in the application.
- 4a) Of the above claim(s) 8, 9, 11-15, 31-35 and 39 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 7, 10, 16-30, 36-38 and 40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 July 2007 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- ☐ Notice of Informal Patent Application
- ☐ Other: _____

DETAILED ACTION

1. Applicants' amendment of claims 7-9, 11, 12, 27, 28, 30, 31, 32, 35, and 38 in the paper filed on 07/30/2007 is acknowledged.
2. Applicant's traverse of the restriction requirement of claims 8, 9, 11-15, 31-35 and 39 by original presentation in the reply filed on 07/30/2007 is acknowledged. The traversal is on the ground(s) that claim 8 should be examined as it presents no additional burden if claim 7 is allowed. This is not found persuasive because claim 7 is not allowed and examination of claim 8 presents an additional burden. For further and prior explanation see the Office Action mailed on 01/25/2007.

The requirement is still deemed proper and is therefore made FINAL.

Claims 7, 10, 16-30, 36-38, and 40 are pending and at issue.

3. Applicants' arguments filed on 07/30/2007 have been fully considered and are deemed to be persuasive to overcome some of the rejections previously applied. Rejections and/or objections not reiterated from previous office actions are hereby withdrawn.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Objections and Rejections that are Withdrawn

4. The objection to the abstract is withdrawn in light of the Applicant's amendment of the abstract.
5. The objection to the title is withdrawn in light of the Applicant's amendment of the title.
6. The figures filed on 07/30/2007 are accepted.
7. The objection for improper use of trademarks is withdrawn. Applicant's use of trademarks is proper.

Sequences In Compliance

8. The amendment of the specification to be in compliance with sequence rules is acknowledged and accepted.

Claim Objections Withdrawn

9. The objections to claims 27 and 37 are withdrawn in light of Applicant's amendment of these claims to recite "5' end".

Claim Rejections Withdrawn - 35 USC § 112 Second Paragraph

10. The rejections of claims 28, 30, and 38 under 35 USC § 112 Second Paragraph are withdrawn in light of the Applicant's amendment of these claims to overcome the rejections.

Restriction Requirement and Rejections that are Maintained

Claim Rejections Maintained - 35 USC § 102

11. The rejection of claims 7, 10, 16-24, 26, 28, 30, 36, 38, and 40 under 35 U.S.C. 102(b) as being anticipated by Lorincz et al. (2000) are maintained.

Applicant's arguments filed 07/30/2007 have been fully considered but they are not persuasive.

Applicant first argues that Lorincz et al. teach anti-sense promoter primers but do not teach a sense promoter primer. However, Lorincz et al. teach both anti-sense promoter primers and sense promoter primers by teaching:

"The method uses an oligonucleotide comprising at least one segment complementary to one strand of a target sequence and a segment containing a promoter" (see column 5 lines 46-48).

As Lorincz et al. teach above that the promoter primer can be complementary to either strand of a target sequence, that is, to either the sense or anti-sense strand; Lorincz et al. teach both anti-sense promoter primers and the sense promoter primers.

Lorincz et al. confirm this by further teaching:

"This oligonucleotide primer, when hybridized to a strand of a template, preferably the anti-sense strand, and extended can generate a copy of the target nucleic acid with the capability of transcription via the added promoter sequence" (see column 5 lines 47-52).

Lorincz et al. thus teach the primer hybridized to the sense strand as well.

Lorincz et al. teach the sense promoter primers of the instant claims.

Applicant further argues that Lorincz et al. do not teach formation of circular substrate but Lorincz et al. explicitly teach a circular substrate:

"In one preferred embodiment, a nucleic acid and a promoter-primer are hybridized. . . . Upon hybridization, the primer portions of the promoter-primer link the 5' and 3' end portions of the target region of nucleic acid, such that the promoter sequence portion is sandwiched between the two hybridized end sequences. The result of this hybridization is the formation of a circle" (see column 5 lines 55-67).

In argument, Applicant admits that Lorincz et al. also teach that a ligase may be reacted with the hybrid to form a continuous transcription ready template (see Applicant argument on p. 16 which refers to Lorincz et al. at column 6 lines 52-65) which when applied to the above hybrid form, as Lorincz et al. teach can optionally be done, is the claimed ligated circular substrate for making transcription products.

Thus the claims are anticipated by Lorincz et al. and the rejection is maintained.

Claim Rejections Maintained - 35 USC § 103

12. The rejection of claims 25, 27, 29, and 37 under 35 U.S.C. 103(a) as being unpatentable over Lorincz et al. (2000) and further in view of Hall et al. (1999) is maintained.

Applicant's arguments filed 07/30/2007 have been fully considered but they are not persuasive.

Applicant argues that these rejections should be withdrawn as Lorincz et al. are argued not to anticipate the base claims. However the rejection of the base claims is maintained as noted above. Therefore, the rejection of claims 25, 27, 29, and 37 is also maintained.

Conclusion

13. Claims 7, 10, 16-30, 36-38, and 40 are not free of the prior art.

14. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark Staples whose telephone number is (571) 272-

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9053. The examiner can normally be reached on Monday through Thursday, 9:00 a.m. to 6:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Benzion can be reached on (571) 272-0782. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Mark Staples
Examiner
Art Unit 1637
October 25, 2007

MS


KENNETH R. HORLICK, PH.D.
PRIMARY EXAMINER

10/29/07